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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/373,585	08/13/1999	NOBUHIKO OGURA	Q55432	2737

7590 12/02/2004

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WASHINGTON, DC 200373202

EXAMINER

LU, FRANK WEI MIN

ART UNIT	PAPER NUMBER
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1634

DATE MAILED: 12/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/373,585

Applicant(s)

OGURA, NOBUHIKO

Examiner

Frank W Lu

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 12 November 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 6, 7, and 21-25.

Claim(s) withdrawn from consideration: _____

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☒ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). 6/22/2004.
10. ☐ Other: _____

ADVISORY ACTION

Response to Amendment

1. Applicant's response to the office action and amendment filed on November 12, 2004 has been entered.

Response to Arguments

I. In page 4, third paragraph of applicant's remarks, applicant argues that "[T]he references cited in the Japanese Office Action correspond to the U.S. Patents and Publication listed in the Form-1449 filed on June 22, 2004. It appears that all relevant information has been placed before the Examiner. In that connection, Applicant respectfully requests that the Examiner initial the PTO Form-1449 filed on June 22, 2004 and April 29, 2004".

This argument has been fully considered. However, note that PTO Form-1449 filed on May 6, 2004 was initialed by the examiner and attached to the final office action mailed on July 13, 2004. Furthermore, there is no PTO Form-1449 filed on April 29, 2004. Since IDS filed on June 22, 2004 was not available when the examiner wrote the final rejection, the examiner now signs PTO Form-1449 filed on June 22, 2004 and attaches the PTO Form-1449 with this advisory action.

II. In page 4, last paragraph of applicant's remarks, applicant argues that "[A]pplicant has amended claim 21 as suggested by the Examiner. Consequently, the objection to claim 21 should be withdrawn".

In view of applicant's amendment filed on November 12, 2004, the examiner agrees to withdraw this objection.

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III. In page 5, last paragraph of applicant's remarks, applicant argues that "[C]laim 1 recites 'a cutting means which cuts the sheet-like substrate bearing thereon the plurality of specific binding agents in the first direction into a plurality of strips'. Column 12, lines 11-15 of Stimpson describe that cutting the rod or spiral bundles to form the arrays can be accomplished by using mechanical or laser methods. Razors or knife blades can be used to manually cut porous polymeric material to give arrays .2-1 mm thick. Column 14, lines 53-58 describe that a 1-2 mm length of the bundles was allowed to extend from the end of the metal tube and an array slab was cut with a razor blade using the metal tube as a guide to obtain a uniform straight cut. However, Stimpson does not disclose a sheet-like substrate, which is a structural limitation of claim 1, nor does Stimpson disclose a cutting means which cuts a sheet-like substrate into strips. The cutter disclosed in Stimpson cuts rod or spiral bundles. The orientation or method of cutting as described by claim 6 is not a necessary result in Stimpson".

These arguments have been fully considered but they are not persuasive toward the withdrawal of the rejection. First, claim 1 has been canceled by applicant. Second, since Stimpson teaches that an array slab is cut with a razor blade using the metal tube as a guide to obtain a uniform straight cut (see column 14, last paragraph), Stimpson disclose a cutting means which cuts a sheet-like substrate into strips.

IV. In page 6, first to third paragraph of applicant's remarks, applicant argues: (1) "[T]he sheet-like substrate and the plurality of strips are clearly structural elements. Moreover, a functional limitation must be evaluated and considered just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which

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it is used”; and (2) “the examiner has not established wherein all of the structural and functional limitations of claim 6 are taught in the art”.

These arguments have been fully considered but they are not persuasive toward the withdrawal of the rejection. First, since the phrase “for manufacturing a test piece for use in biological analysis of a sample organism” is an intended use of the apparatus recited in claim 6 (a functional limitation) and is not a structural limitation of claim 6, a test piece recited in claim 6 is not a part of the apparatus. Furthermore, since the phrase “test piece for use in biological analysis of a sample organism comprising a strip-like substrate bearing thereon numbers of known specific binding agents which are different from each other and are arranged in a line at predetermined intervals in the longitudinal direction of the strip-like substrate” is used to limit the test piece, the strip-like substrate recited in claim 6 is not a part of the apparatus and is not a structural limitation of the apparatus recited in claim 6. Since the phrase “which cuts the sheet-like substrate bearing thereon the plurality of specific binding agents in the first direction into a plurality of strips” is used to define the function of a cutting means, a plurality of strips is not a part of the apparatus recited in claim 6. Therefore, the sheet-like substrate and the plurality of strips are not structural elements of the apparatus recited in claim 6 and the apparatus recited in claim 6 only requires a plurality of applicators, a conveyor and a cutting means. Second, MPEP 2114 (R-1) clearly states that “[W]hile features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board’s finding of anticipation of claimed apparatus because the limitations at

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issue were found to be inherent in the prior art reference); see also *In re Swinehart*, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). '[A]pparatus claims cover what a device is, not what a device does.' *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original)" and "[A] claim containing a 'recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus' if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987). Since Stimpson as evidence by US Patent No. 4,877,745 teaches all structural limitations of claim 6 and applicant has no evidence to show that the apparatus taught by Stimpson as evidence by US Patent No. 4,877,745 cannot perform functions recited in claim 6, the examiner considers that Stimpson as evidence by US Patent No. 4,877,745 teaches all limitations recited in claim 6.

V. In page 6, fourth paragraph bridging to page 8, first paragraph of applicant's remarks, applicant argues: (1) "merely because both references teach a conveyor does not mean that the references teach the conveyor as claimed. The Examiner cannot randomly pick and choose elements of the prior art to teach the claimed elements when there is clearly no motivation or suggestion for the combination"; (2) "[T]he Examiner's reasoning is clearly a result of impermissible hindsight"; and (3) "the references are not analogous merely because both references teach a conveyor" since "[S]huminov is clearly not in the same field of endeavor as the applicant's invention nor does".

These arguments have been fully considered but they are not persuasive toward the withdrawal of the rejection. First, although Shuminov's patent is not from biological field,

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Shuminov's patent is considered as an analogous art because both Stimpson (see column 8, third paragraph and Figure 2C) and Shuminov (see Figure 4a and column 6, lines 5-21) teach conveyor and "conveyor" is a key element to connect Stimpson's patent and Shuminov's patent. Second, applicant has no evidence to show that the examiner randomly picks and chooses elements of the prior art to teach the claimed elements when there is clearly no motivation or suggestion for the combination. In fact, Shuminov provides a motivation to combine the patents of Stimpson and Shuminov (see the rejection under 35 U.S.C 103 (a) in the final rejection mailed on July 13, 2004). Third, in response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

2. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CAR § 1.6(d)). The CM Fax Center number is (703) 872-9306.

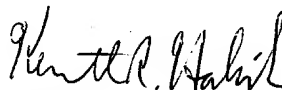
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Lu, Ph.D., whose telephone number is 571-272-0746. The examiner can normally be reached on Monday-Friday from 9 A.M. to 5 P.M.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones, can be reached on (571)-272-0745.

Any inquiry of a general nature or relating to the status of this application should be directed to the Chemical Matrix receptionist whose telephone number is (703) 308-0196.

Frank Lu
PSA
November 30, 2004


KENNETH R. HORLICK, PH.D
PRIMARY EXAMINER

12/1/04